

U.S. Patent Application No. 09/848,954

REMARKS

Reconsideration and allowance of the subject application in view of the foregoing amendments and the following remarks is respectfully requested.

The specification is amended to correct inadvertent grammatical and typographic errors.

Claims 1-30 remain pending in the application.

The rejection of claims 1-30 under 35 U.S.C. 112, first paragraph, is hereby traversed.

Based on the description found at page 12, line 14 through page 13, line 9, and more specifically at page 13, lines 5-9, it is believed that, contrary to the Examiner's first assertion regarding disclosure of using only the assistance signal when the satellite signals have inadequate SNR, the subject matter was described in the specification in a way to reasonably convey to persons skilled in the art that at the time of the invention the inventors had possession of the claimed invention. As described in the instant specification, if the signal from the satellite is too weak to receive Ephemeris data, the receiver calculates position using the Ephemeris data received from a terrestrial broadcast station. (Instant specification at page 13, lines 5-9)

Further, at pages 17, line 20 through page 23, line 19, an embodiment of a positioning system according to the instant claimed invention is described. Specifically, at page 21, lines 18, a description of operation of the positioning system using only the assistance signal during a period of inadequate satellite signal SNR is provided.

When the signal is weak, such as in an obstructed area (a low SNR condition), Ephemeris data may be stored in memory 816 . . . from the SPS receiver. Then it may be used in later conditions where the signal is too weak to allow Ephemeris data to be collected by the SPS receiver. Thus, operation of the aided SPS receiver may continue for a time . . . until the Ephemeris data goes out of date. . . . The position computation block 815 takes as its inputs Ephemeris data derived from the . . . data from the aiding SPS receiver 812 (Instant specification at page 21, lines 1-10)

U.S. Patent Application No. 09/848,954

Based on the foregoing, the subject matter of the claimed invention is believed to have been described in the specification in a way to reasonably convey to persons skilled in the art that at the time of the invention the inventors had possession of the claimed invention. For at least the foregoing reason, the rejection of claim 1 should be withdrawn.

Further, contrary to the Examiner's second assertion regarding disclosure of how positioning is determined using only the assistance signal, it is believed that the subject matter was described in the specification at at least pages 17, line 20 through page 23, line 19, in a way to reasonably convey to persons skilled in the art that at the time of the invention the inventors had possession of the claimed invention. As further illuminated at page 21, lines 14-17, "the signal correlation and tracking module 813 does not work independently of the filter matched to the C/A code and navigation message bits (block 806). The is because the SNR of the received signal may be inadequate to allow the received signal to be tracked." The Examiner is referred to Figure 8 and the above mentioned portions of the specification for further detail regarding how positioning is determined. Based on the foregoing, the subject matter of the claimed invention is believed to have been described in the specification in a way to reasonably convey to persons skilled in the art that at the time of the invention the inventors had possession of the claimed invention. For at least the foregoing reason, the rejection of claim 1 should be withdrawn.

Further, contrary to the Examiner's third assertion regarding disclosure of the claim term "inadequate", it is believed that the subject matter was described in the specification at at least 21, lines 14-20 of the Instant Specification, in a way to reasonably convey to persons skilled in the art that at the time of the invention the inventors had possession of the claimed invention. That is, "the SNR of the received signal may be inadequate to allow the received signal to be tracked." Additionally, page 13, lines 5-6, recites a determination is made to see "if the signal from the satellite is too weak to receive Ephemeris data," page 21, line 1, recites "[w]hen the signal is weak, such as in an obstructed area (a low SNR condition)", and page 21, lines 3-4, recite "in later conditions where the signal is too weak to allow Ephemeris data to be collected by the SPS receiver" all of which further describe the claim term "inadequate" such that a person of ordinary skill would understand at the time of the invention that the inventors had possession of the claimed invention. For at least the foregoing reason, the rejection of claim 1 should be withdrawn.

U.S. Patent Application No. 09/848,954

Further and with respect to each of the above Examiner assertions, the Examiner has the initial burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in applicant's disclosure a description of the invention defined by the claims. The Examiner has failed to meet this burden. The Examiner has failed to provide reasons why persons skilled in the art would not have recognized that the inventor was in possession of the invention as claimed in view of the above noted disclosure. It is believed that one skilled in the art would: (1) understand using only an assistance signal when satellite signals have inadequate SNR, (2) understand how positioning is determined using only the assistance signal, and (3) know what an inadequate SNR is based on the disclosure in the specification. For at least the foregoing reason, the rejection of claim 1 should be withdrawn.

Further still, it is believed that the disclosure reasonably conveys to a person of ordinary skill in the art that the inventor had possession at the time of filing of the claimed subject matter. There is a strong presumption that an adequate written description of the claimed invention is present when the application is filed. In re Wertheim, 541 F.2d 257, 263, 191 USPQ 90, 97 (CCPA 1976) ("we are of the opinion that the PTO has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims"). For at least the foregoing reason, the rejection of claim 1 should be withdrawn.

The Examiner is respectfully requested to provide findings identifying the claim limitations at issue and reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the above remarks and the instant specification.

Furthermore, the Examiner's attention is directed to the description at pages 7, line 12 through page 8, line 14 of a working example of an embodiment of the claimed subject matter. "As long as the specification discloses at least one method for making and using the claimed invention that bears a reasonable correlation to the entire scope of the claim, then the enablement requirement of 35 U.S.C. 112 is satisfied." In re Fisher, 427 R.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970). For at least the foregoing reason, the rejection of claim 1 should be withdrawn.

For any of the above reasons, the rejection of claims 1-30 should be withdrawn.

U.S. Patent Application No. 09/848,954.

Taylor et al. (U.S. Patent 4,445,118, hereafter referred to as Taylor) fails to anticipate the present claimed invention of claim 1. A rejection based on anticipation under 35 U.S.C. §102 requires every element of the claim to be included in the reference, either directly or inherently. Taylor fails to identify all elements of claim 1 either directly or inherently. Applicants arguments previously presented in the After Final Amendments filed March 1, 2004 and September 8, 2003, and the Amendment filed September 16, 2002 regarding the Taylor reference are hereby incorporated herein by reference as they have never been addressed by the Examiner. "All words in a claim must be considered in judging the patentability of a claim against the prior art." In re Wilson, 424 F.2d 1382, 165 USPQ 494 (CCPA 1970). Further, in order to avoid a piecemeal examination of the instant claims, the Examiner is requested to examine the entirety of the claim with respect to the cited prior art and in light of Applicants previously presented arguments.

Further, the Examiner is requested to clarify the statement at page 3, lines 20-23, specifically, "such feature is not sufficiently disclosed in the specification, is considered new matter and is not considered as being a part of the claim (as it is required to be cancelled)." (emphasis added) Per MPEP Section 2163.06 (I), new matter added to the claims are rejected under 35 U.S.C. 112, first paragraph; new subject matter added to the disclosure is objected to under 35 U.S.C. 132 and required to be cancelled. As such, the added claim limitations are not new matter and are not required to be cancelled and should be considered by the Examiner.

In conjunction with the foregoing request regarding examination of the entirety of the claims, the Examiner is referred to MPEP Section 2163.06 regarding a discussion of the relationship of written description requirement to new matter. More specifically, "[t]he examiner should still consider the subject matter added to the claim in making rejections based on prior art since the new matter rejection may be overcome by applicant." (emphasis added)

For at least the above reasons, claim 1 is patentable over Taylor and it is respectfully requested that the rejection be withdrawn.

Claims 2-6, and 9 depend from claim 1, incorporate further important limitations, and are patentable over Taylor for at least the reasons advanced above with respect to claim 1. The rejection of claims 2-6, and 9 should be withdrawn.

Claims 11-16, 19, 21-26, and 29 are patentable over Taylor for reasons similar to those advanced above with respect to claim 1. The rejection of claims 11-16, 19, 21-26, and 29 should

U.S. Patent Application No. 09/848,954

be withdrawn.

Krasner (U.S. Patent 6,064,336, hereafter referred to as Krasner) fails to anticipate the present claimed invention of claim 1. A rejection based on anticipation under 35 U.S.C. §102 requires every element of the claim to be included in the reference, either directly or inherently. Krasner fails to identify all elements of claim 1 either directly or inherently. Applicants arguments previously presented in the After Final Amendments filed March 1, 2004 and September 8, 2003, and the Amendment filed September 16, 2002 regarding the Krasner reference are hereby incorporated herein by reference as they have never been addressed by the Examiner. "All words in a claim must be considered in judging the patentability of a claim against the prior art." In re Wilson, 424 F.2d 1382, 165 USPQ 494 (CCPA 1970). Further, in order to avoid a piecemeal examination of the instant claims, the Examiner is requested to examine the entirety of the claim with respect to the cited prior art and in light of Applicants previously presented arguments.

Further, the Examiner is requested to clarify the statement at page 4, last line through page 5, line 2, specifically, "such feature is not sufficiently disclosed in the specification, is considered new matter and is not considered as being a part of the claim (as it is required to be cancelled)." (emphasis added) Per MPEP Section 2163.06 (I), new matter added to the claims are rejected under 35 U.S.C. 112, first paragraph; new subject matter added to the disclosure is objected to under 35 U.S.C. 132 and required to be cancelled. As such, the added claim limitations are not new matter and are not required to be cancelled and should be considered by the Examiner.

In conjunction with the foregoing request regarding examination of the entirety of the claims, the Examiner is referred to MPEP Section 2163.06 regarding a discussion of the relationship of written description requirement to new matter. More specifically, "[t]he examiner should still consider the subject matter added to the claim in making rejections based on prior art since the new matter rejection may be overcome by applicant." (emphasis added)

For at least the above reasons, claim 1 is patentable over Krasner and it is respectfully requested that the rejection be withdrawn.

Claims 2-7, and 9-10 depend from claim 1, incorporate further important limitations, and are patentable over Krasner for at least the reasons advanced above with respect to claim 1. The

U.S. Patent Application No. 09/848,954

rejection of claims 2-6, and 9-10 should be withdrawn.

Claims 11-17, 19-27, and 29-30 are patentable over Krasner for reasons similar to those advanced above with respect to claim 1. The rejection of claims 11-17, 19-27, and 29-30 should be withdrawn.

Richton et al. (U.S. Patent 6,114,991, hereafter referred to as Richton) in combination with either Taylor or Kresner fails to render obvious the present claimed invention of claim 1. Applicants arguments previously presented in the After Final Amendments filed March 1, 2004 and September 8, 2003, and the Amendment filed September 16, 2002 regarding the Richton reference in combination with either the Taylor or Kresner references are hereby incorporated herein by reference as they have never been addressed by the Examiner. "All words in a claim must be considered in judging the patentability of a claim against the prior art." In re Wilson, 424 F.2d 1382, 165 USPQ 494 (CCPA 1970). Further, in order to avoid a piecemeal examination of the instant claims, the Examiner is requested to examine the entirety of the claim with respect to the cited prior art and in light of Applicants previously presented arguments.

For at least the above reasons, claim 1 is patentable over Richton in combination with either Taylor or Kresner and it is respectfully requested that the rejection be withdrawn.

Claims 7 and 8 depend from claim 1, incorporate further important limitations, and are patentable over Richton in combination with either Taylor or Kresner for at least the reasons advanced above with respect to claim 1. The rejection of claims 7 and 8 should be withdrawn.

Claims 17, 18, 27, and 28 are patentable over Richton in combination with either Taylor or Kresner for reasons similar to those advanced above with respect to claim 1. The rejection of claims 17, 18, 27, and 28 should be withdrawn.

All objections and rejections having been addressed, it is respectfully submitted that the present application should be in condition for allowance and a Notice to that effect is earnestly solicited.

Early issuance of a Notice of Allowance is courteously solicited.

The Examiner is invited to telephone the undersigned, Applicant's attorney of record, to facilitate advancement of the present application.

U.S. Patent Application No. 09/848,954

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 07-1337 and please credit any excess fees to such deposit account.

Respectfully submitted,

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